

### **REMARKS**

Claims 1-21 and 23-44 are now pending in the application, of which Claims 13-15 and 39 have been withdrawn from consideration. Claims 1-12, 16-21, 23-38, and 40-44 stand rejected. Claims 1, 9, 11, 16, 20, 32, and 36 have been amended. Support for the amendments can be found throughout the application, drawings and claims as originally filed and, as such, no new matter has been presented. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **ALLOWABLE SUBJECT MATTER**

The previous indication of allowability of Claims 9-12, 22, 23, 26, and 32-24 has been withdrawn in view of the art of record, as well as the newly cited reference to Marinek (U.S. Pat. No. 6,840,953) (see below).

### **REJECTION UNDER 35 U.S.C. § 112**

Claims 11 and 12 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. Claim 11 has been non-narrowingly amended to overcome this rejection and is believed to now be in condition for allowance. As such, Claim 12 no longer depends upon an indefinite base claim. Therefore, reconsideration and withdrawal of this rejection are respectfully requested.

## **REJECTION UNDER 35 U.S.C. § 102**

Claims 9-12, 20, 21, 26, 28, 29, and 32-35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Greenfield (U.S. Pat. No. 5,584,835). With respect to the rejection of Claim 9, the Office Action cites the Greenfield reference as teaching a cutting portion (207) which forms an implant engaging surface (by threading implant 50). Applicants traverse this characterization.

At the onset, Applicants respectfully assert that the element (207) of the Greenfield reference is not a cutting surface, but is a tool driving surface. In this regard, Applicants direct the Examiner's attention to Claim 9 of the instant application, which contains the limitation that the cutting surface is configured to form an implant engaging surface within a work material. There is simply no teaching or suggestion that the radial extensions (207) of Greenfield are configured to form an implant engaging surface in a work material as claimed (see column 11, lines 42-49 of the Greenfield reference).

The Examiner's attention is directed to independent Claims 20 and 32. These claims contain the limitation that the staple is bindingly engaged in both the implant and a surface defining the bone aperture. Applicants note that the staple or inserted fastener of Greenfield does not engage a surface defining a bone aperture.

Claims 16-19 stand rejected as being anticipated by Kohrs et al. (U.S. Pat. No. 5,897,593). With respect to the rejection of Claim 16, the Examiner cites Figure 14 of the Kohrs reference as teaching a staple. Applicants respectfully traverse this characterization. The Examiner's attention is directed to column 6, lines 38-60, which describe the cited structure as an input drive and not as a staple. It is noted, the Office Action acknowledges that there is no staple in the Kohrs reference in the rejections

under 35 U.S.C. §103. As the reference does not contain all of the claimed elements, the reference is not sufficient to show the claims are prima facie anticipated.

Claims 36-38 and 40-44 stand rejected as being anticipated by Martinek (U.S. Pat. No. 6,840,953). The Examiner's attention is directed to independent Claim 36. Claim 36 has been amended to clarify that cutting surface accepting channels are defined in an exterior surface of the implant so as to position the cutting surfaces within the channel. Applicants note that the cutting elements of the Martinek reference are not positioned within channels in an exterior surface of the implant. Similarly, none of the references teach coupling soft tissue to the implant.

#### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1-8, 20, 23-25, 27, 30, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohrs et al. in view of Michelson (U.S. Pat. No. 6,120,503). This rejection is respectfully traversed.

The Examiner's attention is directed to independent Claims 1 and 9. Claims 1 and 9 have been amended to include the limitation that the fastener is at least partially disposed within a plurality of channels defined in a contoured portion of the implant. Similarly, Claims 20 and 32 have been amended to clarify that the insertion of the staple into a slot is inserting the staple in a slot defined within an exterior contoured surface of the implant to prevent rotation of the implant. Applicants submit there is no teaching in the cited references to place an anti-rotation staple within a slot formed in the contoured surfaces of the implant.

Applicants submit that there is no motivation to combine the cited references to place the staple of Michelson within the channels of Kohrs inasmuch as the projections (16) and (17) are fully disposed within the bone and not in contact with the threads of the implant. Applicants submit that the staple of Michelson is configured to join adjacent bone structures and not couple soft tissue to the implant. Positioning the staple in the channel of Kohrs would not couple the adjacent bone structures. Applicant submits this changes a principle of operation of the Michelson reference. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900,221 USPQ 1125 (Fed. Cir. 1984) MPEP 2143.01. Additionally, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (C.C.P.A. 1959) MPEP 2143.01. Withdrawal of the rejections is respectfully requested.


#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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